

## EXHIBIT 9

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

~~Bank of America, N.A.~~

ASKELOADDEN L.L.C.,

Petitioner,

v.

VERIFY SMART CORP.,

Patent Owner.

Case IPR2017-

Patent No. 8,285,648

**PETITION FOR ~~COVERED BUSINESS~~**  
**METHOD PATENT *INTER PARTES* REVIEW**  
**OF CLAIMS 1-19 OF U.S. PATENT NO.**  
**8,285,648 ~~CHALLENGING CLAIMS 1-19~~**  
**UNDER 35 U.S.C. § 321, 37 C.F.R. §**  
**42.3048,285,648**

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Patent Trial and Appeal Board

United States Patent and Trademark Office

P.O. Box 1450

Alexandria, VA 22313-1450

647515.1

Pursuant to 35 U.S.C. §§311-319 and 37 C.F.R. §42, Askeladden L.L.C. (“Petitioner”) respectfully petitions for *Inter Partes* Review of Claims 1-19 of U.S. Patent No. 8,285,648 (“the ‘648 Patent,” Ex.1001), which is believed to be currently assigned to Verify Smart Corp. (“Verify Smart” or “Patent Owner”). Petitioner submits the Expert Declaration of Ivan Zatkovich (Ex.1002) in support of this Petition. As demonstrated herein with the support of testimonial evidence, there is a reasonable likelihood that Petitioner will prevail in establishing that at least one of the challenged claims is unpatentable. Accordingly, institution of an IPR under 37 C.F.R. §42.108 is requested.

## **I. INTRODUCTION**

U.S. Patent No. 8,285,648 (the “‘648 Patent”) is directed to the abstract idea of using a verification code (e.g., a password) to verify the identity of a user in a financial transaction. Specifically, The ‘648 Patent discloses a method and claims a system and method for verifying a user’s identity wherein the identity of a user in a financial transaction. During an enrollment process, a user is assigned a PIN or password (“bona fide secure identifier”), which is stored in a “verifier-database” accessible to a “verifier-computer.” *See* (Ex.1001-at 4:24-29; 6:52- 55; Fig. 1-). When the user wishes to ~~conduct~~execute a financial transaction such as a credit card purchase, the verifier-computer opens a communications link and sends an “identity verification request (IVR)” to the user, for example as an SMS text message, requesting user’s mobile device, which requests entry of the assigned PIN or password. (*Id.* at 4:34-41; 8:13-39-). In response, the user enters and sends a password (“putative secure identifier”), *id.* at 8:51-57” to the verifier-computer, which the verifier-computer compares to the previously assigned bona fide secure identifier. If they match, the financial transaction is allowed to proceed. *Id.* at 9:5-10.

~~Alice Corp. test, and are invalid under 35 U.S.C. § 101.~~

**~~B. — Ground 2: Claims 1-3, 5-7, 9-12, And 19 Are Invalid Under § 102 (a) And (b) As Anticipated By Law~~**

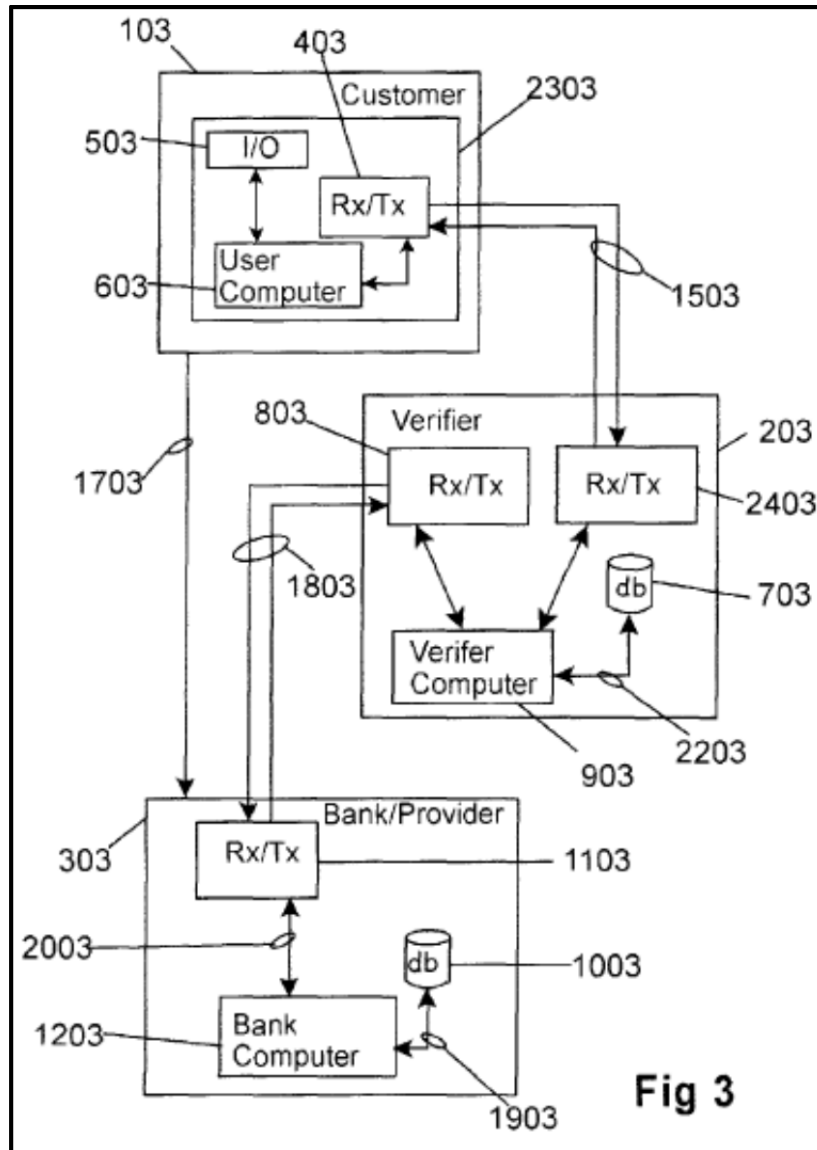
~~Law, titled “Secure Wireless Authorization System,” was published on August 25, 2005. Thus, Law qualifies as and is therefore prior art to the ’648 Patent under 35 U.S.C. § 102 (a) and (b), and is a permissible basis for this Petition pursuant to AIA § 18(a)(1)(C).~~ The USPTO did not consider Law during the prosecution of the application leading to the ’648 Patent.

**~~1. — Overview of Law~~**

Law discloses “a secure wireless authorization system by which a user can employ a wireless device to authorize a request that is initiated by a remote third party and transmitted to the user by an authorization server.” ~~(Ex. 1007 at 1005, Abstract).~~ Law describes three authorization models that can be implemented with the disclosed system: pre-authorization, real-time authorization and post-authorization. ~~Ex. 1007 ¶(Id. at ¶42).~~

~~42. These models can operate individually, in a pair, or all in unison. Id.~~ Of particular relevance ~~to this Petition~~ here is the real-time authorization model shown in Figure 3, ~~(reproduced below)~~, in which ~~the identity of~~ a user is authenticated during a financial transaction. ~~(Id. ¶ at ¶47, Fig. 3. Figure 6 shows a variation of this real-time authorization model in which the~~

~~authorization server initiates the connection.~~<sup>2</sup> ~~Id. ¶¶ 61-62, Fig. 6, 3).~~ Like the claimed invention of the ’648 Patent, ~~(Ex. 1001, 9:55-57),~~ the real-time authorization model disclosed ~~in~~ by Law (Fig. 3 or 6) can be used to verify the identity of a buyer in a ~~credit-card~~ financial transaction. ~~Ex. 1001 at 9:55-57; (Ex. 1007 ¶ 1005 at ¶21).~~



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‘company X requests action Y for an amount Z, would you like to proceed?’ would be displayed on the wireless device.” (Id. at ¶49).

The user authorizes the transaction by entering a PIN number, which is transmitted back to the authorization server. (Id. ¶-at ¶49-). If the PIN provided is correct (i.e., matches one previously stored for that user), the authorization server sends a response back to the third party to allow the transaction to proceed. (Id. ¶ at ¶50). See Fig. 6 reproduced below.

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Therefore, this Petition should be granted, *Inter Partes* Review should be instituted, and Claims 1-3, 5-7, 9-12, 19 should be found unpatentable and 19 of the '648 Patent are invalid under 35 U.S.C. § 102(a) and (b), cancelled by the Board.

Respectfully submitted,

/s/ Marc J. Pensabene

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Dated: January 18, 2017  
New York, New York

By: /Charles R. Macedo/  
Charles R. Macedo  
Registration No.: 32,781

U.S. Patent No.

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. §§42.6(e) and 42.105, I hereby certify that on ~~August 12, 2015, I caused this~~ 18<sup>th</sup> day of January 2017, a true ~~and correct~~ copy of the following materials:

~~Petition for Covered Business Method Patent Review foregoing PETITION FOR INTER PARTES REVIEW OF CLAIMS 1-19 OF U.S. PATENT NO. 8,285,648 Challenging Claims 1-19 Under 35 U.S.C. § 321, 37 C.F.R., together § 42.304~~

- ~~Exhibits with Petitioner's Power of Attorney, Petitioner's Exhibit List, and Exhibit Nos. 1001-1011 of Petition for Covered Business Method Patent Review of U.S. Patent No. 8,285,648~~

~~to be, was~~ served via Priority Mail Express-Mail<sup>®</sup> on the patent owner at the following attorney correspondence address of record ~~as listed on PAIR:~~

~~Denis O'Brien for VERMETTE & CO.  
1177 West Hastings Street, Suite  
320 Vancouver, BC  
Canada V6E 2K3~~

~~I also hereby certify that on August 12, 2015, I caused a true and correct copy of the Petition for Covered Business Method Patent Review and Exhibits to be served via Express Mail on the following party listed under "Correspondence Address" on PAIR subject patent:~~

~~DAN SCAMMELL  
1729 Hampton Drive  
Coquitlam, BC, CANADA V3E 3C9~~

~~In addition, service is also made at the following "address known to the petitioner as likely to effect service" pursuant to 37 C.F.R. §42.105(a):~~

~~VERMETTE & CO.~~

~~I also hereby certify that on August 12, 2015, I caused a true and correct copy of the Petition for Covered Business Method Patent Review and Exhibits to be served via Express Mail on the following party alleged to be the owner of U.S. Patent No.~~



U.S. Patent No.  
8,285,648 Petition for Covered Business Method

~~8,285,648 in the litigation *Verify Smart Corp. v. Bank of America, N.A.*, Case No.~~

~~2:15-cv-05348 MCA MAH, pending in the U.S. District Court for the District of  
New Jersey:~~

~~Verify Smart Corp. c/o Robert C.  
Harris 1177 West Hastings Street,  
Suite 320 Vancouver, BC, CANADA  
V6E 2K3~~

~~Anthony Cinotti  
President and Director  
VERIFY SMART CORP.  
564 Wedge Lane  
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~~A courtesy copy was also sent to the alleged patent owner's litigation  
counsel at the following address:~~

~~Jean-Marc Zimmerman  
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PARAY LLP  
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Westfield, NJ 07090~~

~~/s/ Daniel Levy — Daniel Levy (Reg. No. 60,966)~~

U.S. Patent No.  
8,285,648 Petition for Covered Business Method

Dated: January 18, 2017  
New York, New York

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